REMARKS

The Final Office Action dated May 7, 2008 contained a final rejection of claims 1-4, 6-14 and 16-21. Claims 17 and 18 have been canceled and claims 1 and 11 have been amended. Please consider the present amendment with the attached Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. This amendment is in accordance with 37 C.F.R. § 1.114. Reexamination and reconsideration of the application, as amended, are requested.

Rejection under 35 U.S.C. § 102(b)

The Office Action rejected claims 1, 4, 9 and 9 under 35 U.S.C. § 102(b) as being anticipated by Khormaee (U.S. Patent No. 5,397,192).

The Applicant respectfully traverses this rejection based on the amendments to the claims and the arguments below.

Specifically, the Applicant's independent claims now include utilizing the placement shift parameters to shift the back side image to align with the front side image placement, digitally shifting the image in a direction aligned with or transverse to a medium advance axis after the print medium is flipped and when the print medium is non-square and digitally rotating the image after the print medium is flipped and when the print medium is non-parallel.

In contrast, although Khormaee disclose a shuttle-type printer that includes a platen and a carriage configured to move bidirectionally across the platen (see Abstract of Khormaee), in view of the amendments to the independent claims (at least incorporating claims 17 and 18 into the independent claims), all of the features of the

Applicant's claimed invention are not disclosed in Khormaee. Hence, the rejection under 35 U.S.C. § 102(b) should be withdrawn.

Rejections under 35 U.S.C. § 102(b)

The Office Action rejected claims 2, 3 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Khormaee in view of Ohsumi et al. (U.S. Patent No. 6,052,552). The Office Action rejected claims 7-8 under 35 U.S.C. § 103(a) as being unpatentable over Khormaee in view of Mizubata et al. (U.S. Patent No. 6,888,650). The Office Action rejected claims 11-14, 16, 19 and 20-21 under 35 U.S.C. § 103(a) as being unpatentable over Ohsumi et al. in view of Kato and further in view of Wibbels et al. (U.S. Patent No. 6,118,950) and further in view of Khormaee. The Office Action rejected claims 17-18 under 35 U.S.C. § 103(a) as being unpatentable over Ohsumi et al. in view of Kato in further view of Wibbels et al. in view of Khormaee and further in view of Mizubata.

The Applicant respectfully traverses these rejections based on the amendments to the claims and the arguments below.

Namely, all of the features of the Applicant's claimed invention are not disclosed, taught or suggested alone or in any combination of the cited references. Specifically, even when Khormaee is combined with the other **four** cited references (for a total of **five** references), the combination **unquestionably** does **not** disclose all of these elements. Although the Examiner argued on page 9 of the June 9, 2008 Office Action that "Mizubata discloses this theta shift limitation in column 7, lines 36-42," the Applicant respectfully disagrees with this statement. Instead, the Applicant submits that Mizubata discloses rotating a **same image** on the same page in a **non-duplex** printing mode. Namely, Mizubata **explicitly** states that "…the same image as that of the document can be output even without reading part of the margin of the document. Thereafter, the image is rotated based on the skew quantity Θ detected by the reading controller 20…" (see col. 7, lines 37-40 of Mizubata).

This is unlike the Applicant's shifting the back side image in **duplex** printing mode by digitally shifting the back side image in a direction aligned with or transverse to a medium advance after the print medium is flipped and when the print medium is non-

square; and digitally rotating the back side image after the print medium is flipped and when the print medium is non-parallel. As such, because the combined cited references, in any combination, do not disclose all of the features of the claims, the rejection of the claims under 35 U.S.C. § 103(a) should be withdrawn (MPEP 2143).

Further, even though the combination of the **five** cited references does not produce all of the elements of the claimed invention, these references should not even be considered together since there is no motivation to combine the cited references. First, there must be a basis in the references for combining or modifying the references and hindsight cannot be used to form this basis. For example, the Examiner cannot use a "tack-on" approach to arbitrarily "pick and choose" elements from numerous references and combine these elements with the benefit of hindsight.

Evidence that the Examiner used hindsight is clearly confirmed by the fact that the Examiner combined **five** (5) references in a piecemeal fashion without providing any reasoning for combining these references when rejecting claims 17 and 18. Contrary to the Examiner's approach, the Applicant submits that there must be some reason, suggestion, or motivation found in the references whereby a person of ordinary skill in the field of the invention would make the combination, and that knowledge **cannot** come from the Applicant's invention itself.

Therefore, because the combined references are missing features of the Applicant's claimed invention and because the Examiner used improper hindsight, the combined references cannot render the Applicant's invention obvious. This failure of the cited reference to disclose, suggest or provide motivation for the Applicant's claimed invention clearly indicates a lack of a prima facie case of obviousness and, thus, the obviousness rejection should be withdrawn (MPEP 2143).

With regard to the rejection of the dependent claims, because they depend from the above-argued respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable (MPEP § 2143.03).

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly **requests** the Examiner to telephone the Applicant's attorney at **(818) 885-1575**. Please note that all mail correspondence should continue to be directed to:

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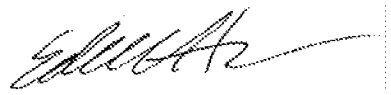

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